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1 The above-entitled matter came on for hearing Wednesday,
2 September 1, 2010, commencing at 9:24 a.m., at the U.S. Patent and
3 Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Deborah
4 Courville, a Notary Public.

5 THE USHER: Good morning. This is Calendar No. 2, Appeal
6 No. 2010-008257, Mr. Edward Tracy, Jr.

7 JUDGE JEFFERY: Okay, thank you. Good morning.

8 MR. TRACY: Good morning.

9 JUDGE JEFFERY: Okay, good morning. You have 20 minutes, and
10 you can begin whenever you'd like.

11 MR. TRACY: Thank you. Well, the first thing that I'd like to note is
12 I know there's a recent Board case that stated that you cannot enter new
13 arguments in the Reply Brief or in the Oral Hearing that were not in the
14 Appeal Brief unless you're responding to things that were not in the Final
15 Office Action. And I'd like to note that the Reply Brief is a reply to things
16 that were newly described -- newly asserted in the Examiner's Answer. The
17 Examiner's interpretation that because the claims recite by user input then
18 therefore they can't be automatic -- which was first raised, I believe, in the
19 Examiner's Answer -- and that's all of the discussion, you know, today, and
20 then the Reply Brief, I think, is proper and shouldn't fall under that ruling.

21 And so to get into the merits, the issue apparently, you know, in
22 seeing the Examiner's Answer is the claimed invention recites that a user
23 input is provided and, in response to the user input, text is horizontally
24 scrolled and -- is automatically horizontally scrolled and then automatically
25 vertically scrolled. And the Examiner has said that, well, because a user
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1 input is needed that it can't be automatic and, therefore, it doesn't
2 distinguish over the reference, which only describes manual scrolling. And
3 I'd also like to note that the rejection is an anticipation rejection and the
4 standard for anticipation rejection is that the reference, the single reference
5 must describe the claimed invention in as great of detail as included in the
6 claims -- as recited in the claims.

7 And the reference *Tsuk* describes a manual scrolling device, a device
8 that, you know, will move, for example, a curser based on a person rotating
9 a controller, and it's -- the whole inventive aspect of *Tsuk* is the faster you
10 rotate it, it can then create an acceleration factor to allow you to scroll
11 through a list faster. And especially if you have an extremely long list to go
12 through, you can spin the control part faster and, thus, get a faster scrolling
13 affect. But in all cases in *Tsuk*, it describes that the scrolling is directly
14 related to the movement by the user. If the user stops moving the controller,
15 then it stops scrolling. You know, in contrast, again, the claimed invention
16 recites that a user input is provided and then text is horizontally scrolled, and
17 then vertically scrolled. And, you know, the Examiner has asserted that,
18 well, it's not really automatic because a user input is required, and, you
19 know, certainly, the applicants think that that's incorrect, you know, that
20 that's an unreasonable interpretation of the word automatic.

21 Certainly, there are many automatic control devices and I'm unaware
22 of any that do not receive any user input. For example, a wall clock
23 automatically keeps the time. You've got to plug it in. You've got to put
24 batteries in it. The idea that anything automatically controls something with
25 no user input ever would mean nothing is automatic, you know.

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1 JUDGE JEFFERY: Counsel, you would dispute that the cited
2 reference both horizontally scrolls and vertically scrolls? Well, leaving
3 aside the manual versus automatic aspect at the moment, just -- you
4 wouldn't dispute that point?

5 MR. TRACY: Well, I would dispute that with respect to our claims, it
6 describes that you could, you know, configure it to vertically or horizontally
7 scroll using the device.

8 JUDGE JEFFERY: But not both?

9 MR. TRACY: I'm not sure. There's only the one, you know, part
10 that you rotate. There would have to be some other controller. How does it
11 decide whether you're intending to horizontally or vertically scroll at any
12 one time? You're not, you know, simultaneously horizontally and vertically
13 scrolling.

14 JUDGE JEFFERY: But you can do both functions some way,
15 shaping -- the user can select whether to go horizontally or vertically?

16 MR. TRACY: That is possible, but it doesn't describe that and we
17 certainly don't think that you can say that it anticipates the claims when it
18 doesn't even mention how you would do that. I mean, certainly, there could
19 be a button or a switch to move back and forth horizontal or vertical, but it
20 certainly doesn't describe that. And it -- again, it describes it could be set up
21 to horizontally or vertically scroll and it doesn't necessarily say that, you
22 know, that that would be changeable on any particular -- you know, it could
23 be that it's set up only to vertically scroll, for example. And I think,
24 certainly, with an iPod, which is, you know, this is an Apple patent or
25 publication, generally, they're horizontally -- I'm sorry -- they're vertically
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1 scrolling to go through all the songs. And, you know, I don't have an iPod,
2 but I don't know of any -- you know, maybe it's possible that it does include
3 that control, but, again, this doesn't describe that type of control that would
4 allow you to switch back and forth between horizontal and vertical scrolling.

5 And, you know, to also discuss the aspect of, you know, what we
6 think is a reasonable interpretation of automatic, for example, you know, an
7 air conditioning system, I think everyone would agree that it automatically
8 controls the temperature in the building. Does it never get any user input?
9 Of course not. You plug in 75 degrees, and then from that point on it
10 automatically controls the temperature to be 75 degrees. I don't have to
11 keep turning on and off the air conditioning unit or the furnace myself.
12 Again, the Examiner's interpretation that any user input renders it not
13 automatic would, again -- I don't know of a human-created device that
14 would then be automatic. Every human-created device -- yes?

15 JUDGE CAROLYN THOMAS: Counselor, can you identify in the --
16 in your spec where you talk about this automatic feature? [After a two
17 minute pause by Counselor looking through the Specification] Well,
18 counselor, let me add that I was unable to find any disclosure about
19 automatically scrolling, either horizontally or vertically, but what I did find
20 on page 21 of the spec is disclosure pertaining to scrolling only when
21 instruction for subsequent scrolling is given from a user. And my question
22 to you is how is that distinguishable from the *Tsuk* reference?

23 MR. TRACY: Well, I believe the -- what the invention does is you
24 would hit, for example, a start aspect, you know, a start button -- you know,
25 you would click on something and then the scrolling would begin and it
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1 would scroll horizontally and then vertically. And, again, you would just
2 provide the command to scroll. You wouldn't be manually controlling, i.e.,
3 providing a command that scrolls based on, you know, or proportional to
4 your command and the scrolling immediately stopping when your input
5 stops. Again, the specification describes just a single user entry, a single
6 user command to scroll horizontally and then vertically.

7 And again, in comparison with the prior art, *Tsuk*, in each
8 embodiment describes, for example, in 69, in paragraph 69 of the
9 publication, that you can linearly scroll through a list of media just by
10 providing a rotational input, using a rotational input device. In paragraph
11 84, it describes that after a rotational movement has been received the
12 rotational movement is converted into a linear movement and it's applied to
13 one object of the graphical user interface. So in each case, it's moving items
14 on the interface in direct proportion to an input from a user, which is, again,
15 not what's claimed in the present application.

16 JUDGE JEFFERY: Okay, if I understand your position correctly, I --
17 if I take a device and cited reference that's an iPod-like device like this and I
18 move the rotational button one way or the other and that -- and the circuitry
19 within the device translates that to a scrolling either vertically or
20 horizontally, whatever it is, that to you is not automatic?

21 MR. TRACY: Correct. That would be manual.

22 JUDGE JEFFERY: That would be manual?

23 MR. TRACY: Right.

24 JUDGE JEFFERY: Notwithstanding the fact that the circuitry within
25 the box itself takes this physical motion and converts it to electrical signals

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1 which then converts it to a display for viewing in a particular fashion, that
2 that's not automatic?

3 MR. TRACY: It's still proportional to the input provided. It's not --
4 you know, if you did a one -- you know, if there were just buttons and you
5 clicked and, like, each click -- well, I guess that's still proportional to your
6 input. But, you know, the rotation -- or, if you rotate it in one direction and
7 it goes one, and then -- so, in other words, regardless of how much you
8 rotate it, it would only go serve one at a time. I think that would be, you
9 know, more -- that would not be manual, you know. The distinction I'm
10 making is --

11 JUDGE JEFFERY: I see. Because that wouldn't be proportional to
12 the input, in other words?

13 MR. TRACY: Right.

14 JUDGE JEFFERY: If I'm rotating 20 times and I get one line down,
15 that -- the circuitry has somehow done some kind of automatic translation
16 that's not commensurate with the user input?

17 MR. TRACY: I -- yes, I think so. What *Tsuk* is describing, which is
18 what I'm characterizing as manual, is that the movement on the screen is
19 proportional to the input.

20 JUDGE JEFFERY: I see.

21 MR. TRACY: And when the input stops, the movement stops.
22 Where, again, the claimed invention, it's -- one command is entered, then
23 the scrolling occurs and it's not proportional to anything.

24 JUDGE JEFFERY: But isn't the motional rotational, though, and the
25 display is vertical? Isn't there some kind of distinction there in terms of

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1 what the user sees versus what the user is physically doing, i.e., the
2 rotational versus vertical or rotational versus horizontal?

3 MR. TRACY: Right. It describes in paragraph 89 of *Tsuk*, I think it
4 is -- I'm sorry, 84, that it translates the rotational motion into a linear
5 movement.

6 JUDGE JEFFERY: And that's not automatic?

7 MR. TRACY: Right. That's manual. And I think what they're
8 saying is that it's not just -- you know, it's in some sort of proportional
9 manner, that, you know, one rotation is one spot, two rotations is two spots,
10 something of that nature. But, again, also *Tsuk* -- again, the main idea of
11 *Tsuk* is that if you spin it faster, it will accelerate that. So, again, it's further
12 describing that the movement is somehow proportional to your user input.

13 JUDGE JEFFERY: All right. Any questions?

14 JUDGE JAMES THOMAS: No further questions.

15 JUDGE JEFFERY: Okay, thank you very much, counselor.

16 MR. TRACY: Thank you.

17 Whereupon, the proceedings, at 9:38 a.m., were concluded.

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